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EXAMINER

ALVAREZ, RAQUEL

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PAPER

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* DAVID N. HARRIS
9

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11 Appeal 2010-004625
12 Application 09/617,361
13 Technology Center 3600
14

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16 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and
17 JOSEPH A. FISCHETTI, *Administrative Patent Judges*.
18 FETTING, *Administrative Patent Judge*.

19 DECISION ON REQUEST FOR REHEARING¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

This is a decision on rehearing in Appeal No. 2010-004625. We have jurisdiction under 35 U.S.C. § 6(b).

Requests for Rehearing are limited to matters misapprehended or overlooked by the Board in rendering the original decision. 37 C.F.R. § 41.52.

ISSUES ON REHEARING

Appellant raises four issues in the Request for Rehearing. The first issue relates to the distinction between claims 60 and 75. The second issue relates to whether claims 117 and 118 recite the manner in which an account holder can change a verification indicator. The third issue relates to the verification request in claim 106. The fourth issue relates to whether Joao describes the limitations added in claims 67 and 82.

ANALYSIS

We found in our decision that claims 60-104, 106, and 109-118 were properly rejected. (Decision 9-10).

The panel found claim 67 anticipated because “the claims at issue to not recite either the timing or manner of such selection.” The Examiner did not distinguish the findings between claims 67 and 75. Ans. 3-5 and 9-10. The panel accordingly affirmed the rejection of claim 75 for the same reason as claim 67. The Appellants argue that claim 75 differs from the panel’s analysis as to claim 67 in that the claimed verification function is sequentially enabled, disabled, and then re-enabled. (Request 6).

1 We find this argument persuasive, and that this claim was separately
2 argued in the Appeal Brief, and so we find the rejection of claims 75-89 as
3 anticipated by Blonder to be improper.

4 We do not find this pertains to computer readable media claims 90-104
5 which nominally refer to claim 75, as the analysis for claim 67 is applicable
6 to these claims, because the actual steps performed by users is outside the
7 scope of such claims directed only to logic structure. It is sufficient that
8 the system described by Blonder would allow such steps to be performed.

9 The panel found that the analysis as to claim 67 also applied to claims
10 106, 117, and 118. Decision 8. Appellants argue that each of these claims
11 recites the manner in which the account-holder can change the verification
12 indicator. Request 7-13. Unlike claim 75, each of these claims are
13 apparatus claims. Appellants argue that the claims recite how these
14 apparatuses are used, but that is not pertinent in structural claims as
15 those of apparatuses. It is sufficient that the apparatus can be operated
16 as suggested in the claims. There is no question that an operator could in
17 fact operate these apparatuses as claimed, because the suggested operation
18 simply describes the sequence in which an operator uses the functionality
19 clearly described in the art. Whether the art suggests that particular
20 sequence is not pertinent in an apparatus claim so long as that sequence
21 is possible.

22 With regard to claim 106, Appellants argue extensively the clause that
23 begins “to facilitate a connection with a financier for receiving a verification
24 request.” All that is necessary for the art to be within the scope of this
25 limitation is anything that would facilitate such receiving a request.

1 Whether the request is with a financier and whether the request is for
2 verification does not affect the facilitative nature of the art. Again,
3 Appellants are arguing steps in a structural claim.

4 With regard to claim 82², Appellants argue the waiting and notification
5 disablement limitations. Neither claim narrows the manner or extent of
6 disablement or what the waiting is specifically based on. The claim merely
7 recites that whatever the waiting is based on, it is somehow tied to the
8 account holder initiating communication. The panel found that Joao
9 describes, in instances when the communication device does not have a
10 reply or two-way pager feature, the cardholder may simply telephone the
11 central processing office or a processing center for the card in order to
12 personally appraise the center or office of his or her response to the central
13 processing computer transmission regarding the transaction. Decision:
14 Finding of Fact 06.

15 There can be little doubt that when the processing center must wait
16 for such a call, no communication in the other direction is enabled by the
17 account holder, for otherwise there would be no need for the account holder
18 to call. This is because, as stated by Joao at the cited Joao 19:1-7, there is
19 no communication capability in the other direction. Thus, Appellants'
20 argument regarding such a reply relates to an embodiment different from
21 that in Joao 19:1-7. Similarly it is clear the processing center waits for the
22 call, as it is the call that triggers its follow on effects.

² Appellants also argue claim 82, but this argument is moot in view of our granting the request to reverse the rejection of claims 75-89.

CONCLUSION

Nothing in Appellant's request has convinced us that we have overlooked or misapprehended the claims and art as argued by Appellant, except for our findings as to claim 75 and its dependent claims. Accordingly, we Grant the request as to claim 75 and its dependent claims 76-89, but DENY the request as to the remaining claims.

DECISION

To summarize, our decision is as follows:

- We have considered the REQUEST FOR REHEARING
- We GRANT the request that we reverse the Examiner as to claims 75-89.
- We DENY the request that we reverse the Examiner as to claims 67, 106, 117, and 118.
- The remaining rejections are unaffected. Thus, the rejection of claims 75-89, 105, 107, and 108 now stands reversed, and the rejection of claims 60-74, 90-104, 106, and 109-118 remains affirmed.

REHEARING GRANTED-IN-PART

JRG